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10/680,630	10/07/2003	Eric G. Hull	427600700080	5078

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EXAMINER

PATEL, DHIRUBHAI R

ART UNIT

PAPER NUMBER

2831

DATE MAILED: 04/20/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

10/680,630

Applicant(s)

HULL ET AL.

Examiner

DHIRU R PATEL

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 07 October 2003.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-21 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-21 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

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***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103 (a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(f) or (g) prior art under 35 U.S.C. 103(a).

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1. Claims 1- 4, 6-11, 13-18 and 20-21 are rejected under 35 U.S.C. § 103 (a) as being unpatentable over Maier (4,057,164) in view of McEvers (6,239,365).

Maier discloses:

Regarding claim 1, an electrical outlet box 12 (see fig 1) molded in one-piece material with a mounting flange 28 (one of flange) thereon (see fig 1, column 3 lines 60-66), said flange extending generally perpendicular to one box sidewall for attaching the box to a front surface of a wall stud 27 (see fig 3) , but fails to disclose a second flange (other flange) extending generally parallel to an opposite box sidewall on an opposite side of the box from said flange for attaching the box to a side surface of a wall stud and the box being made from a one-piece of plastic material . McEvers teaches the use of a flange 36 extending generally parallel to an opposite box 10 sidewall on an opposite side of the box (see fig 1, column 6 lines 50-60) in order to mount the box 10 to the side of a stud 60 (see column 6 lines 50-55). Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to provide a second flange extending generally parallel to an opposite box sidewall on an opposite side of the box of the assembly of Maier as taught by McEvers in order to facilitate mount the box 12 to the side of the stud 27. With respect to the box being made from a one-piece of plastic material. It would have been obvious to one having ordinary skill in the art at the time the invention was made to provide the modified assembly of Maier with to the box being made from a one-piece of plastic material , since it has been held to be within the general skill of a worker in the art to select a known material on the

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basis of its suitability for the intended use as a matter of obvious design choice. In re Leshin, 125 USPQ 416.

Regarding claim 2, the modified assembly of Maier disclose all the features of the claimed invention as shown above, including said box has a front opening with a front opening plane (see fig 1 of Maier), said one flange having a rear flange surface facing away from said plane (see fig 1 of Maier) and said other flange having a front flange surface facing toward said plane, and both said rear flange surface and said front flange surface being spaced the same distance from said plane. It is noted that the modified assembly of Maier meet the structural limitations.

Regarding claims 3 and 6, the modified assembly of Maier disclose all the features of the claimed invention as shown above, including said box has a front opening with a front opening plane (for claim 6), and said one flange has a flange thickness generally perpendicular to said plane and said other flange has a flange thickness generally parallel to said plane, but fails to disclose said flange thickness of said other flange being greater than said flange thickness of said one flange. it would have been an obvious matter of design choice to use said flange thickness of said other flange being greater than said flange thickness of said one flange , since applicant has not disclosed that said flange thickness of said other flange being greater than said flange thickness of said one flange solves any stated problem or is for any particular purpose and it appears that the invention would perform equally well with if designed with said flange thickness of said other flange being greater than said flange thickness of said one flange of the modified

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assembly of Maier. It is noted that the modified assembly of Maier meet the structural limitations.

Regarding claims 4 and 7, the modified assembly of Maier disclose all the features of the claimed invention as shown above, including said box has a front opening with a front opening plane (for claim 7), said one flange has a flange width generally parallel to said plane and said other flange has a flange width generally perpendicular to said plane, but fails to disclose said flange width of said one flange being greater than said flange width of said other flange. it would have been an obvious matter of design choice to use said flange width of said one flange being greater than said flange width of said other flange, since applicant has not disclosed that said flange width of said one flange being greater than said flange width of said other flange solves any stated problem or is for any particular purpose and it appears that the invention would perform equally well with if designed with said flange width of said one flange being greater than said flange width of said other flange of the modified assembly of Maier. It is noted that the modified assembly of Maier meet the structural limitations.

Maier discloses:

Regarding claim 8, an electrical outlet box 12 (see fig 1) molded in one-piece material, said box having opposite sides and opposite ends (see fig 2), a mounting flange 28 (one of flange, see fig 1, column 3 lines 60-66) on one of said sides for mounting said box to a wall stud 27(see fig 3), one of said flanges extending outwardly from one of said sides generally perpendicular thereto (see fig 1), but fails to disclose a second flange

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(other flange) extending outwardly from said ends generally parallel to the other of said sides and the box being made from a one-piece of plastic material . McEvers teaches the use of a flange 36 extending generally parallel to an opposite box 10 sidewall on an opposite side of the box (see fig 1) in order to mount the box 10 to the side of a stud 60 (see column 6 lines 50-55).

Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to provide a second flange extending generally parallel to an opposite box sidewall on an opposite side of the box of the assembly of Maier as taught by McEvers in order to facilitate mount the box 12 to the side of the stud 27. With respect to the box being made from a one-piece of plastic material. It would have been obvious to one having ordinary skill in the art at the time the invention was made to provide the modified assembly of Maier with to the box being made from a one-piece of plastic material , since it has been held to be within the general skill of a worker in the art to select a known material on the basis of its suitability for the intended use as a matter of obvious design choice. In re Leshin, 125 USPQ 416.

Regarding claim 9, the modified assembly of Maier disclose all the features of the claimed invention as shown above, including said box has a front opening with a front opening plane (see fig 1 of Maier), said one flange having a rear flange surface facing away from said plane (see fig 1 of Maier), and with respect to said other flange having a front flange surface facing toward said plane and both said rear flange surface and said front flange surface being spaced the same distance from said plane. It is noted that the modified

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assembly of Maier meet the structural limitations.

Regarding claim 10, the modified assembly of Maier disclose all the features of the claimed invention as shown above, including and said one flange has a flange thickness generally perpendicular to said plane and said other flange has a flange thickness generally parallel to said plane, but fails to disclose said flange thickness of said other flange being greater than said flange thickness of said one flange. it would have been an obvious matter of design choice to use said flange thickness of said other flange being greater than said flange thickness of said one flange , since applicant has not disclosed that said flange thickness of said other flange being greater than said flange thickness of said one flange solves any stated problem or is for any particular purpose and it appears that the invention would perform equally well with if designed with said flange thickness of said other flange being greater than said flange thickness of said one flange of the modified assembly of Maier. It is noted that the modified assembly of Maier meet the structural limitations.

Regarding claim 11, the modified assembly of Maier disclose all the features of the claimed invention as shown above, including said one flange has a flange width generally parallel to said plane and-said other flange has a flange width generally perpendicular to said plane, but fails to disclose said flange width of said one flange being greater than said flange width of said other flange. it would have been an obvious matter of design choice to use said flange width of said one flange being greater than said flange width of said other flange, since applicant has not disclosed that said flange width of said one



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flange being greater than said flange width of said other flange solves any stated problem or is for any particular purpose and it appears that the invention would perform equally well with if designed with said flange width of said one flange being greater than said flange width of said other flange of the modified assembly of Maier. It is noted that the modified assembly of Maier meet the structural limitations.

Regarding claim 13, the modified assembly of Maier disclose all the features of the claimed invention as shown above, including said box has a front opening with a front opening plane (see fig 1 of Maier), said one flange has a flange thickness generally perpendicular to said plane and said other flange has a flange thickness generally parallel to said plane, but fails to disclose said flange thickness of said other flange being greater than said flange thickness of said one flange. it would have been an obvious matter of design choice to use said flange thickness of said other flange being greater than said flange thickness of said one flange , since applicant has not disclosed that said flange thickness of said other flange being greater than said flange thickness of said one flange solves any stated problem or is for any particular purpose and it appears that the invention would perform equally well with if designed with said flange thickness of said other flange being greater than said flange thickness of said one flange of the modified assembly of Maier. It is noted that the modified assembly of Maier meet the structural limitations.

Regarding claim 14, the modified assembly of Maier disclose all the features of the claimed invention as shown above, including said box has a front opening with a front

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opening plane (see fig 1 of Maier), said one flange has a flange width generally parallel to said plane and-said other flange has a flange width generally perpendicular to said plane, but fails to disclose said flange width of said one flange being greater than said flange width of said other flange. it would have been an obvious matter of design choice to use said flange width of said one flange being greater than said flange width of said other flange , since applicant has not disclosed that said flange width of said one flange being greater than said flange width of said other flange solves any stated problem or is for any particular purpose and it appears that the invention would perform equally well with if designed with said flange width of said one flange being greater than said flange width of said other flange of the modified assembly of Maier. It is noted that the modified assembly of Maier meet the structural limitations.

Maier discloses:

Regarding claim 15, an electrical outlet box 12 (see fig 1) molded in one-piece material, said box having opposite sidewalls 16, top and bottom walls, a rear wall and a front opening opposite from said rear wall, said front opening having an opening periphery that lies in a plane (see fig 1, column 3 lines 30-55), a first mounting flange 28 ( one of flange, see fig 1, column 3 lines 60-66) extending outwardly from one of said sidewalls generally parallel to said plan for attaching said box to a front surface of a wall stud and being spaced toward said rear wall from said plane (see fig 1), but fails to disclose a second mounting flange (other flange) extending outwardly from the other of said sidewalls generally perpendicular to said plane for attaching said box to a side surface of a wall

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stud and being spaced toward said rear wall from said plane, and said second mounting flange extending outwardly beyond both said top and bottom walls, and the box being made from a one-piece of plastic material . McEvers teaches the use of a flange 26 extending outwardly from the other of said sidewalls generally perpendicular to said plane and said mounting flange extending outwardly beyond both said top and bottom walls (see fig 1) in order to mount the box 10 to the side of a stud 60 (see column 6 lines 50-55).

Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to provide a second flange extending generally parallel to an opposite box sidewall on an opposite side of the box of the assembly of Maier as taught by McEvers in order to facilitate mount the box 12 to the side of the stud 27. With respect to the box being made from a one-piece of plastic material. It would have been obvious to one having ordinary skill in the art at the time the invention was made to provide the modified assembly of Maier with to the box being made from a one-piece of plastic material , since it has been held to be within the general skill of a worker in the art to select a known material on the basis of its suitability for the intended use as a matter of obvious design choice. In re Leshin, 125 USPQ 416.

Regarding claim 16, the modified assembly of Maier disclose all the features of the claimed invention as shown above, including said one flange having a rear flange surface facing away from said plane (see fig 1 of Maier), and with respect to said other flange having a front flange surface facing toward said plane and both said rear flange surface

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and said front flange surface being spaced the same distance from said plane. It is noted that the modified assembly of Maier meet the structural limitations.

Regarding claims 17 and 20, the modified assembly of Maier disclose all the features of the claimed invention as shown above, including said one flange has a flange thickness generally perpendicular to said plane and said other flange has a flange thickness generally parallel to said plane, but fails to disclose and said flange thickness of said other flange being greater than said flange thickness of said one flange. it would have been an obvious matter of design choice to use said flange thickness of said other flange being greater than said flange thickness of said one flange , since applicant has not disclosed that said flange thickness of said other flange being greater than said flange thickness of said one flange solves any stated problem or is for any particular purpose and it appears that the invention would perform equally well with if designed with said flange thickness of said other flange being greater than said flange thickness of said one flange of the modified assembly of Maier.

Regarding claims 18 and 21, the modified assembly of Maier disclose all the features of the claimed invention as shown above, including said one flange has a flange width generally parallel to said plane and-said other flange has a flange width generally perpendicular to said plane, but fails to disclose said flange width of said one flange being greater than said flange width of said other flange. it would have been an obvious matter of design choice to use said flange width of said one flange being greater than . said flange width of said other flange , since applicant has not disclosed that said flange

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width of said one flange being greater than said flange width of said other flange solves any stated problem or is for any particular purpose and it appears that the invention would perform equally well with if designed with said flange width of said one flange being greater, than said flange width of said other flange of the modified assembly of Maier.

***Allowable Subject Matter***

2. Claims 5, 12 and 19 objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

The following is a statement of reasons for the indication of allowable subject matter:

The primary reason for the indication of the allowability of claims 5, 12 and 19 are the inclusion therein, in combination as currently claimed, of the limitation of abutments projecting outwardly from the sidewall on which said other flange is located (for claims 5, 12 and 19).

The previously listed limitation is neither disclosed nor taught by the prior art of record, alone or in combination.

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**Contact information**

3. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Dhiru Patel whose telephone number is (571) 272--1983. The examiner can normally be reached on Mondays- Thursdays from 6:30 am to 4:00 pm. The fax number for this Group is 703-872-9306. Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is (571) 272-2800 ext 31.

Dhiru Patel  
Primary Examiner  
Group Art Unit 2831  
April 15, 2004

*Dhiru R Patel*  
*Primary Examiner*  
*4/15/04.*